

STATEMENT CONCERNING COMMON OWNERSHIP

The instant application and Monahan et al. (U.S. Patent No. 6,523,037, hereinafter “Monahan”) were owned by, or subject to an obligation of assignment to, eBay Inc. at the time of invention of subject matter claimed in the instant application.

REMARKS

This paper responds to the Final Office Action mailed on May 15, 2009.

Claims 1, 12, 22, and 32 are amended. Claim 4 is herein canceled, and claims 2, 13, and 23 remain canceled. No claims are added. As a result, claims 1, 3, 5-12, 14-22, and 24-32 are now pending in this application.

§ 103 Rejection of the Claims

Claims 1-3, 9-14, 19-24 and 29-32 were rejected under 35 U.S.C. § 103(a) as being obvious over Dettinger et al. (U.S. Patent No. 6,947,928, hereinafter “Dettinger”) in view of Williamowski et al. (U.S. Patent No. 6,434,546, hereinafter “Williamowski”). A determination of obviousness requires a factual showing that “the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”¹

Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined.²

Applicants respectfully submit that a determination of obviousness is not established for the reason that the scope and content of the cited references, even if combined, do not teach or suggest Applicants’ claimed subject matter or support rational inferences that one skilled in the art reasonably would be expected to draw to reach Applicants’ claimed subject matter.

Independent claims 1, 12, 22, and 32 are each amended herein to recite, in part, “the database forming part of a **network-based commerce facility**,”³ which is a limitation previously recited and examined in claim 4, canceled herein. Claim 4 was rejected in view of Monahan, as discussed below with respect to claims 4-8, 15-18, and 25-28. With respect to claims 1, 12, 22, and 32, the Final Office Action stated that “Dettinger in view of [Williamowski] does not expressly teach the method wherein the database forms part of a network-based commerce

¹ *Graham v. John Deere*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966).

² *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 U.S.P.Q.2d 1385 (2007).

³ Claims 1, 12, 22, and 32, emphasis added.

facility.”⁴ Applicants agree. As a result, the scope and content of Dettinger and Williamowski do not teach or suggest Applicants’ claimed subject matter or support rational inferences that one skilled in the art reasonably would be expected to draw to reach Applicants’ claimed subject matter. For at least these reasons, a determination of obviousness is not established with respect to any of independent claims 1, 12, 22, and 32, and their respective dependent claims. Thus, Applicants respectfully request that these rejections be withdrawn and the claims be allowed.

Claims 4-8, 15-18, and 25-28 were rejected under 35 U.S.C. § 103(a) as being obvious over Dettinger in view of Williamowski and in further view of Monahan. In particular, the Final Office Action relied on Monahan in rejecting claim 4 and stated that “Monahan teaches a database that presents user selectable search fields where the **database is connected to an e-commerce network**.”⁵ Applicants respectfully submit that Monahan is disqualified as prior art under 35 U.S.C. § 103(c).⁶

In order to be disqualified as prior art under 35 U.S.C. 103(c), the subject matter which would otherwise be prior art to the claimed invention and the claimed invention must be commonly owned, or subject to an obligation of assignment to a same person, at the time the claimed invention was made or be subject to a joint research agreement at the time the invention was made.⁷

Furthermore, as set forth in the MPEP:

Applications and references . . . will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person.⁸

The Final Office Action stated that “[Monahan] constitutes prior art only under 35 U.S.C. 102(e).”⁹ As noted above, Applicants herein state that the instant application and Monahan were

⁴ Final Office Action, page 8.

⁵ Final Office Action, page 8, emphasis added.

⁶ 35 U.S.C. § 103(c)(1), “Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (c), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.”

⁷ MPEP 706.02(1)(2).

⁸ *Id.*

⁹ Final Office Action, page 8.

owned by, or subject to an obligation of assignment to, eBay Inc. at the time of invention of subject matter claimed in the instant application. As a result, Monahan is disqualified as prior art under 35 U.S.C. § 103(c) and does not preclude patentability under 35 USC § 103(a) of the independent claims 1, 12, 22, and 32, as amended herein. For at least these reasons, a determination of obviousness is not established with respect to any of independent claims 1, 12, 22, and 32, and their respective dependent claims, including claims 5-8, 15-18, and 25-28. Thus, Applicants respectfully request that these rejections be withdrawn and the claims be allowed.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned at (408) 278-4048 to facilitate prosecution of this application.


If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402--0938
(408) 278-4048

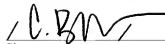
Date 15 July 2009

By


Joseph J. Wang
Reg. No. 61,123

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 15th day of July, 2009.

Chris Bartl
Name


Signature